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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/10/07;05/30/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 4, 5, 8, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-8, 11-13, 17, 18, 21-23, 27 and 30-52 of copending Application No. 10/959,186. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are same scope, limitation and meaning.

Regarding claims 1, 2, 4, 5, 8, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29, Application No. 10/959,186 teaches a cordless telephone, comprising: a remote

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handset, a base unit matched to said remote handset, and an MPEG audio player integrated within at least one of said remote handset and said base unit, wherein said remote handset of said cordless telephone can switch between performing as a telephony device and performing as said MPEG audio player (see Application No. 10/959,186, claims 6-8, 11-13, 17, 18, 21-23, 27 and 30-52).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Young, III (US 5,694,467).

Regarding claims 1 and 29, Sato teaches a cordless telephone (see Title and Abstract), comprising: a remote handset (see Drawing handset 37), a base unit matched to the remote handset (see Drawing base unit 24), and an audio player integrated within at least one of the remote handset and the base unit (see Title, Abstract and Detailed Description).

Sato does not specifically disclose an MPEG audio integrated within at least one of the remote handset and the base unit.

Borland teaches an MPEG audio integrated within at least one of the remote handset and the base unit (see Abstract, column 5, lines 37-40, column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", also see column 3, line 65 to column 4, line 7, "MPEG" and see column 5, lines 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose a user of the telephone may initiate an action to mute music playing from the audio when the telephone receives a telephone call.

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Young teaches a user of the telephone may initiate an action to mute music playing from the audio when the telephone receives a telephone call (see column 2, lines 25-41 and Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Young into the system of Sato and Borland in order to improve in sound headset systems and telephone headset systems (see Young, column 1, lines 7-9).

Regarding claim 2, the combination of Sato, Borland and Young teaches the MPEG audio player is integrated within the remote handset (see Sato, Title, Abstract and Detailed Description, and see Borland, column 5, lines 24-28).

Regarding claims 4 and 5, the combination of Sato, Borland and Young further teaches the MPEG audio player is an MP3 (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3").

6. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Tuoriniemi et al (US 5,978,689) and Young, III (US 5,694,467).

Regarding claims 9, 10, 19 and 20, Sato teaches a method of integrating an MPEG audio player in a cordless telephone (see Title and Abstract) comprising: playing of the pre-loaded music from the remote handset of a cordless telephone (see Title, Abstract and Detailed Description), connecting a base unit of the cordless telephone to

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a public switch telephone network (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network).

Sato does not specifically disclose a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3.

Borland teaches a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3 (see column 5, lines 24-28 and column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Sato and Borland so that the user won't miss the telephone call while enjoy listening to music.

The combination of Sato, Borland and Tuoriniemi does not specifically disclose muting the playing of the music by an action initiated by a user.

Young teaches muting the playing of the music by an action initiated by a user (see column 2, lines 25-41 and Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Young into the system of Sato, Borland and Tuoriniemi in order to improve in sound headset systems and telephone headset systems (see Young, column 1, lines 7-9).

7. Claims 14, 15, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Segal et al (US 6,167,251).

Regarding claims 14 and 24, Sato teaches a method of integrating an audio player in a cordless telephone (see Title and Abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 37-40).

Sato does not teach a method of integrating an MPEG audio in a cordless telephone comprising: the downloaded digital bit stream music comprised in an MPEG format.

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Borland teaches a method of integrating an MPEG audio in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", and see column 3, line 65 to column 4, line 7, "MPEG") comprising: the downloaded digital bit stream music comprised in an MPEG format (see column 3, line 65 to column 4, line 7, "MPEG").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format to said remote handset directly from a remote bit stream audio source, and storing said downloaded digital bit stream music comprised in an MPEG format in said remote handset, wherein said downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in said remote handset.

Segal teaches downloading digital bit stream music comprised in an MPEG format to said remote handset directly from a remote bit stream audio source (see column 30, line 15-32 and fig.3), and storing said downloaded digital bit stream music comprised in an MPEG format in said remote handset (see column 30, line 15-32 and fig.3), wherein said downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in said remote handset (also see column 30, line 15-32 and fig.3).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Segal into the system of Sato and Borland for later playback (see Segal, column 30, lines 23-24).

Regarding claims 15, 25 and 28, Sato teaches a method of integrating an audio player in a cordless telephone (see Title and Abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network) comprising: playing music from a remote handset of the cordless telephone (see Title, Abstract and Detailed Description).

Sato does not specifically disclose playing MP3 music from a remote handset of the cordless telephone and the remote bit stream music comprised in a MPEG format to the remote handset via an Internet.

Borland teaches playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28) and the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Segal teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 30, line 15-32 and fig.3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Segal into the system of Sato and Borland for later playback (see Segal, column 30, lines 23-24).

Response to Arguments

8. a. Applicant's arguments with respect to claims 1, 2, 4, 5, 9, 10, 19, 20 and 29 have been considered but are moot in view of the new ground(s) of rejection.

b. Applicant's arguments filed 29/05/07 have been fully considered but they are not persuasive.

On page 8 of applicant's arguments, applicant states that at the appropriate time, the Applicant will submit a terminal disclaimer if necessary to overcome the double patenting rejection.

In response, since applicant fails to submit a terminal disclaimer, the examiner hereby maintains the double patenting rejection as stated in the previous Office action (dated 11/18/06).

On page 9 of applicant's arguments, applicant argues that there is not a reason to integrate an MPEG audio player into Sato.

In response, Sato teaches a cordless phone that plays music, and Borland teaches a cordless phone that plays MPEG, and an MPEG standard used especially for

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digitally transmitting music over the Internet (see Answers.com). Therefore, a reason to integrated an MPEG audio player of Borland into Sato so that the cordless phone of Sato plays MPEG.

On pages 9 and 10 of applicant's arguments, applicant argues that no motivation to combine Sato and Borland.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in the knowledge generally available to one of ordinary skill in the art in order to prevent telephone conversation from interfering with audio sounds.

On pages 9 and 10 of applicant's arguments, applicant argues that Sato and Borland do not disclose having a cordless telephone with an integrated MP3 player that can be used as a telephone or an MP3 audio player.

In response, Borland teaches MP3 player that can be used as a telephone or an MP3 audio player (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", and see column 3, line 65 to column 4, line 7, "MPEG") and the combination of Sato and Borland does indeed teach applicant's claimed limitation.

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On page 10 of applicant's arguments, applicant argues that Tuoriniemi does not have a shortcomings associated with a cordless telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland (not Tuoriniemi) teaches a cordless telephone (see fig.2, base unit 120 and handset 110), and the combination of Sato, Borland, Tuoriniemi and Young (newly cited) does indeed teach applicant's claimed limitation.

On page 11 of applicant's arguments, applicant argues that Tuoriniemi does not teach playing MP3 music from a remote handset of remote handset of a cordless telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland (not Tuoriniemi) teaches playing MP3 music from a remote handset of remote handset of a cordless telephone (see column 5, lines 37-40, Abstract, "MP3", column 4, lines 7-21, "MP3", column 4, lines 48-66, "MPEG" and "MP3", see Borland, column 3, line 65 to column 4, line 7, "MPEG"), and the combination of Sato, Borland, Tuoriniemi and Young (newly cited) does indeed teach applicant's claimed limitation.

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On page 11 of applicant's arguments, applicant argues that the modified combination would still fail to disclose or suggest playing MP3 music from a remote handset of a cordless telephone and a user's muting the playing of a pre-loaded MP3 music when cordless telephone receives a telephone call, as recited by claims 9, 10, 19 and 20.

In response, Sato, Borland, Tuoriniemi and Young (newly cited) does indeed teach applicant's claims 9, 10, 19 and 20. In addition, applicant's attention is directed to the teaching of Sato, Borland, Tuoriniemi and Young (newly cited) in claims 9, 10, 19 and 20 above.

On page 11 of applicant's arguments, applicant argues that Segal does not teach downloading digital bit stream music comprising MPEG format to a remote handset directly from a remote bit stream audio resource accessible by the handset via an Internet as recited by claims 14, 15, 24, 25 and 28.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *downloading digital bit stream music comprising MPEG format to a remote handset directly from a remote bit stream audio resource accessible by the handset via an Internet*) are not recited in the rejected claims 14, 24 and 28. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually

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where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland (not Segal) teaches downloading digital bit stream music comprising MPEG format to a remote handset directly from a remote bit stream audio resource accessible by the handset via an Internet (see column 5, lines 24-28, and column 4, lines 27-33, see "transmission through Internet").

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

